

Remarks

Claims 1-27 are pending in the above-identified application. Claims 1, 15, 26 and 27 are amended and claims 2-24 and 16-25 are original.

In the office action the Examiner, in Section 2, stated: "The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action." However, each of the rejections relies on a combination of a plurality of references, yet the claims are rejected under 35 U.S.C. 102(b). Applicant believes that this is an error, and that the Examiner meant to reject the claims under 35 U.S.C. 103(a). This amendment is based on this assumption.

The Examiner rejected Claims 1, 2-3, 6-10, 15, and 19-21 under 35 U.S.C. 102(b) (Applicant assumes this should be 35 U.S.C. 103(a)) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, Oct-2001, page 22, Steering Wheel with Multifunction buttons).

MPEP §706.02(j) states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." *Id.* at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

With the present amendment each of the independent claims have been amended to more clearly claim that the mobile terminal is user removable from the vehicle. This is supported in the specification, as filed, and as shown in Fig. 1. The integrated hands free mobile system module 100 is mounted in the dashboard 102 of a vehicle and may be operatively connected to a mobile terminal 101. The integrated hands free mobile system 100 has a socket 104 for receiving a plug 106 on a mobile interface cable 108. The mobile interface cable 108 may also have a universal connector 109 for connecting to the mobile terminal 101. The mobile terminal is a wireless mobile terminal, such as

a cell phone, that a user may use normally when it is not coupled to the vehicle. Each of the independent claims have been amended to thus clearly distinguish the claimed invention over Okagaki et al. who teach only a built in telephone (see element 6 in Fig. 1) and not a mobile terminal.

In paragraph 22 of the Patent Publication it states: "The automotive information system of the invention also permits hand-free telephone conversation. To this end, the present invention provides an automotive system comprising a main unit, a wireless telephone unit connected to the main unit, a speaker, and a microphone; wherein the wireless telephone unit includes: means for detecting receipt of a telephone call; and means for sending a start signal to the main unit upon detection of the receipt of the telephone call; wherein the main unit includes: means for detecting the start signal; means for turning on power supply to the main unit in response to the start signal; means for informing a user of the receipt of the telephone call when the power supply to the main unit is turned on in response to the start signal received from the wireless telephone unit; means for detecting a responding operation of the user for responding to the telephone call; and means for sending, when the responding operation is detected, connecting instruction to the wireless telephone unit to request the wireless telephone unit to connect the telephone call to the main unit; wherein the wireless telephone unit further includes: means for detecting the connecting instruction; and means responsive to the connecting instruction, for connecting the telephone call to the main unit; and wherein the main unit further includes means for enabling the user to communicate with the telephone caller by means of the speaker and the microphone." However, the term "wireless" refers to the telephone unit being able to transmit and receive, and not that it is a mobile terminal separate and independent of the vehicle.

Ariyoshi is only cited as teaching a microphone to be placed in the center of the steering wheel. BMW2001, is only cited as teaching a switch (1, 2) in a multifunction steering wheel that allows users to operate the phone quickly with both hands on the wheel. Therefore, no combination of Okagaki et al, Ariyoshi, and BMW2001 would result in the claimed invention as set forth in each of the independent claims. In particular, the processing module being coupled to an integrated hands free mobile system module, and the integrated hands free mobile system module being detachably coupled to a mobile terminal.

The Examiner also rejected independent claims 26 and 27 under 35 U.S.C. 102(b) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, 2000, page 22, Steering Wheel with Multifunction buttons) and further in view of Kashiwamura (US Publication No. 2002/0016188).

However, Kashiwamura does not teach the processing module coupled to an integrated hands free mobile system module, and the integrated hands free mobile system module detachably coupled to a mobile terminal. Thus no combination of Okagaki et al, Ariyoshi, BMW2001, and Kashiwamura would result in the claimed invention as set forth in each of independent claims 26 and 27. Furthermore, these claims have been amended to distinguish over the prior art for the same reasons as set forth with regard to independent claims 1 and 15.

The Examiner also cited Ju, however Ju only teaches an application that allows synchronizations between mobile devices and a PC. The Examiner also cited Eiche, however Eiche only teaches a connector to interface with a variety of external devices including a PC. The other cited art also does not supply the missing elements in the claimed invention as described

above. The Examiner also cited Chen, Kashiwamura, however neither of these references supply the missing elements described above with regard the independent claims.

The dependent claims include all the limitations of the respective independent claims upon which they depend. It has been shown that each of the independent claims, as amended, are not anticipated or obvious in view of any of the cited prior art taken singly or in combination. Therefore, these dependent claims are also allowable over the cited art.

The Examiner also objected to claims 1, 26 and 27. These claims have been amended as suggested by the Examiner. The Examiner is therefore respectfully requested to reconsider the objection to these claims.

Furthermore it is well accepted that, in going from the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led a person skilled in the art to do. One skilled in the art would not have the motivation to combine the cited prior art references. For example, Okagaki et al already provides a microphone and does not suggest that there is any problem with using this microphone. Although Ariyoshi teaches to improve the ratio of an inputted voice to a noise by making the shape of a reflector plate installed so as to be opposed to a microphone in the center of a steering wheel. However, where is the motivation for combining these two references when there appears to be no need for an improved ratio of inputted voice to noise.

The *prima facia* case of obviousness determination has not been made out. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, *arguendo*, that the combination of the applied references is proper, do not teach or

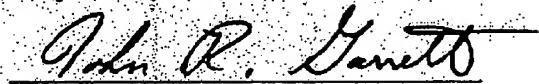
suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If an additional telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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